

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1 and 8 are rejected under 35 U.S.C. 102 (b) over the patent to Ward.

Claims 1-6 and 8-13 are rejected under 35 U.S.C. 102(b) or under 35 U.S.C. 103(a) over the British document to Grube.

At the same time, the claims are rejected under the judicially created doctrine of obviousness type double patenting over the copending patent applications.

Also, claims 7 and 14 were indicated by the Examiner as not rejected over the art, but actually allowable.

The Examiner's indication of the allowability of claim 7 and 14 has been gratefully acknowledged.

In connection with this indication claims 7 and 14 have been amended by introducing into them the features of original claims 1 and 8 to make them independent and it is believed that these claims are now in allowable condition.

In view of the Examiner's rejection of the claims under the judicially created doctrine of obviousness type double patenting, two Terminal Disclaimers have been submitted herewith, disclaiming those portions of a term of a patent which may be issued on this application which can be subsequent to the term of validity of patents issued on the copending applications. It is believed that therefore that the double patenting rejection should also be considered as not tenable and should be withdrawn.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, claims 1 and 8, the broadest claims on file have been amended so as to more clearly define the present invention and to distinguish it from the references applied by the Examiner.

Before the analysis of the prior art it is believed to be advisable to explain the subject matter of the present invention and its new features.

The present invention deals with a washer and a fastener provided with the washer. The washer has radially inner and radially outer parts and a resistive point formed so that when a nut is turned and turns the bolt, the body of the washer stops the bolt from turning and thereby the nut creates a pull on the bolt which elongates the bolt in an axial direction and applies to the body of the washer and to the turning resistant surface an axial force which overcomes the resistive point so that the radially outer part actually does not move radially or axially, but only the radially inner part with the turning resistance surface is displaced axially together with the bolt when the bolt elongates.

Turning now to the references and in particular to the patent to Ward it can be seen that this reference deals with a lock washer. As explained in the first paragraph of column 1 of this reference, the washer is designed for locking a nut, to frictionally contact with the nut and to prevent a casual movement of the nut with respect to the bolt. In contrast, the washer in accordance with the present invention is not a lock washer and it has nothing to do with locking of the nut or preventing its movement with respect to the bolt, but instead the washer of the present invention is designed to allow turning of the nut, but instead to prevent the bolt from turning as explained in detail in the specification. The radially outer and

radially inner parts of the washer disclosed in the reference and the resistive point which is the lug of the lock washer in the patent to Ward are designed so that the tension of the radially inner part is developed in a radial direction which radially inner part moves radially and it also moves axially because the lock washer is compressed in an axial direction, while the tension of the radially outer part is developed in an axial direction which radially outer part moves axially.

This construction has nothing to do with the applicant's invention as now defined in amended claims 1 and 8. As explained herein above, the radially inner and radially outer parts of the body of the washer and the resistive point are formed so that the radially outer part does not move radially or axially, but instead the radially inner part holds the bolt from turning and then axially displaces together with the bolt when the bolt elongates. These features are not disclosed in the patent to Ward and also can not be derived from it as a matter of obviousness.

The original claims were rejected over this reference under 35 U.S.C. 102(b) as anticipated. It is believed that it is advisable to cite the decision in *re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Ward does not have each and every element of the washer and the fastener defined in claims 1 and 8 of the present application, and therefore the anticipation rejection should be considered as no longer tenable with respect to claims 1 and 8 and should be withdrawn.

Turning now to the British reference to Grube, it is respectfully submitted that this reference deals with a fastener which has a bolt extending through an object, and two nuts 10 and 14, wherein the nut 14 is located inside the nut 10. The resistive points specified by the Examiner as formations 32 and 23 are provided between the inner surface of the outer nut 10 and the outer surface of the inner nut 14. The reference does not disclose a washer at all. Both nuts 10 and 14 are displaced axially by turning on the threads of the bolt and neither one holds the bolt from turning. The reference does not disclose a washer at all. Definitely, the reference does not disclose such a washer which is located between a nut and an object and which has a radially inner part and a radially outer part with a resistive point formed so that when the nut turns the radially outer part actually does not move radially or axially, but instead the radially inner part

stops the bolt from the turning and then axially moves together with the bolt. These features are not disclosed in the British reference to Grube.

As for the anticipation rejection of the original claims of the patent to Grube, it is believed that the decision in re Lindemann is completely applicable with respect to this rejection.

As for the rejection of the original claims over the patent to Grube as obvious in the sense 35 U.S.C. 103(a) it is respectfully submitted that the reference does not provide any hint or suggestion for the new features of the present invention. In order to arrive at the applicant's invention from the teaching of the British reference, the reference has to be fundamentally modified by including into the fastener of the reference, the washer which is designed in accordance with the new features of the present invention as defined in claims 1 and 8. However, the reference does not contain anything which would make such modifications obvious. It is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *Re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the British reference does not contain anything which would make obvious the modifications of the construction disclosed in the reference and the new features of the present invention.


In view of the above presented remarks and amendments it is believed that amended claims 1 and 8 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the independent claims, they share their presumably allowable features, and therefore it is respectfully submitted that they should be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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